

REMARKS

Claims 15 to 23 are added, and therefore claims 8 to 213 are pending.

Reconsideration is respectfully requested based on the following.

It is noted that essentially corresponding claims (as previously presented) have been allowed in the corresponding European application.

Claims 8 to 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,212,546 (the “Starkovich” reference) over International Publication No. WO 01/26337 (the “Gelvin” reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 8 is to a device for connecting subnets in a vehicle, including “a gateway unit configured to connect at least two subsystems, wherein the gateway unit is made of at least one modular software gateway, which routes messages between only two subnets.” These software gateways only route information between two networks. In this regard, the specification in the present application explains that “[i]f each subnet is to be connected to each other subnet, $N*(N-1)/2$ logical software gateways are needed, where variable N is the number of subnets in the overall system. Thus, for three subnets, there will be three logical

software gateways; for four subnets there will be six, and for five subnets there will be ten logical software gateways.” (*See specification* pg. 4, lines 20 to 23).

In contrast, the “Starkovich” reference “relates to interfaces which interface a variety of requester types coupled to a server with a variety of communications programs coupled to an **on-line transaction processing system**, and more particularly, to such interfaces which isolate attributes of the requesters and the communications programs into individual software components.” (The “Starkovich” reference, column 1 lines 26 to 32, (emphasis added)).

It is respectfully submitted that the features of claim 8 are not disclosed or even suggested by the “Starkovich” reference. In fact, Fig. 7 in “Starkovich” illustrates each gateways to be connected to a multiplicity of nodes. For example, gateway 498 is connected to connector 510 as well as 512 and 514. Thus, the “Starkovich” reference does not route messages **between only two subnets** as provided for in the context of the claimed subject matter. As explained herein, the modular software gateways described in the present application only route information between two networks. The secondary “Gelvin” reference does not cure, and is not asserted to cure, this critical deficiency. Therefore, the “Starkovich” reference, by itself nor in combination with the “Gelvin” reference, does not disclose nor even suggest the claim feature of “between only two subnets” as provided for in the claimed subject matter.

Accordingly, claim 8 is allowable for these reasons alone, as are its dependent claims.

Further, the “Starkovich” reference does not disclose nor suggest the claim 8 feature of “connecting subnets **in a vehicle**.” In this regard, the Office Action asserts that this critical deficiency is cured by the “Gelvin” reference. However, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning** with some **rational underpinning** to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986) (emphasis added). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (*See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998). Also, the prior art must disclose or suggest each claim feature and it should also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (*See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998).

In contrast to the Supreme Court’s stated guidelines and the case law, the Office Action clearly has not provided any “articulated reasoning with *some rational underpinning* to support the legal conclusion of obviousness”; instead, the Office Action is relying on “mere conclusory statements.” The arguments in the Office Action are essentially that because the “Gelvin” reference teaches claimed features (which it does not) that the “Starkovich” reference is lacking, one of ordinary skill in the art would have sufficient skill and motivation to make the necessary modifications based on the teachings of the applied art to arrive at the claimed invention. However, this assumption is not only completely unsupported, but far-fetched, at best.

First, the Office Action completely and absolutely relies on the “ordinary skill in the Computer Networking art” for the obviousness rejection, but there isn’t any proper evidence regarding what the ordinary skill level in the art is and how it relates to vehicles. Second, simply asserting that it is within the “ordinary skill in the Computer Networking art at ... to combine the teachings of Starkovich with ...with the teachings of Gelvin because having a network in a vehicle allows devices internal and external to the vehicle to communicate” does not provide any meaningful reasoning as to why one of ordinary skill in the art would have been motivated to make the asserted modification.

In this regard, it is respectfully submitted that the “Gelvin” reference is individually complete. Thus, there would be absolutely no reason to combine the teachings of the “Starkovich” reference with those of the “Gelvin” reference because the “Gelvin” reference already provides a modular gateway approach and allows devices internal and external to the vehicle to communicate.” Thus, the Office Action is simply stating, without any supporting evidence, that it would have been obvious to try the combination asserted by the Office Action. However, the “obvious to try” rationale is clearly insufficient to support an obviousness rejection, particularly when the Office Action has not established any finding as to: a) whether the problem addressed by the presently claimed subject matter was recognized in the art; b) whether there was any recognized potential solution to the problem in the art; or c) whether one of ordinary skill in the art could have pursued the recognized potential solution with a reasonable expectation of success. Therefore, it would not be obvious for one skilled in the art to combine, as asserted, the “Starkovich” reference and the “Gelvin” reference.

Claims 9 to 13 depend from claim 8, and are therefore allowable for at least the same reasons as claim 8.

Like claim 8, claim 14 include the feature of a “gateway unit configured to connect at least two subsystems, the gateway unit being integrated in a control unit having an application system and being provided in one layer of a communication system of the vehicle, the gateway unit including at least *one modular logical gateway*, the logical gateway connecting *only two* subsystems.”

It is respectfully submitted that the features of claim 9 are not disclosed or even suggested by the “Starkovich” reference. As discussed in the context of the patentability of claim 8, Fig. 7 in “Starkovich” illustrates each gateway to be connected to a multiplicity of nodes. For example, gateway 498 is connected to connector 510 as well as 512 and 514. Thus, the “Starkovich” reference does not disclose, nor suggest, a logical gateway connecting **only two subnets** as provided for in the context of the claimed subject matter. Further, the secondary “Gelvin” reference does not cure, and is not asserted to cure, this critical deficiency. In fact, Fig. 2 in “Gelvin” indicates that a single gateway node 104 is connected to a **multiplicity of nodes**, including node 3, node 4, node 7, and the internet. Therefore, the “Starkovich” reference, whether taken alone or combined with the “Gelvin” reference, does not disclose nor even suggest the claim feature of “only two subnets” as provided for in the context of the claimed subject matter.

Accordingly, claim 14 is allowable. It is therefore respectfully requested that the obviousness rejections be removed.

New claims 15 to 23 do not add any new matter and are supported by the present application. Claims 15 to 21 depend from claim 14 and are therefore allowable for the same reasons. Claim 22 and 23 depend from claim 8 and are therefore allowable for the same reasons.

In summary, claims 8 to 23 are allowable.

CONCLUSION

In view of the foregoing, all pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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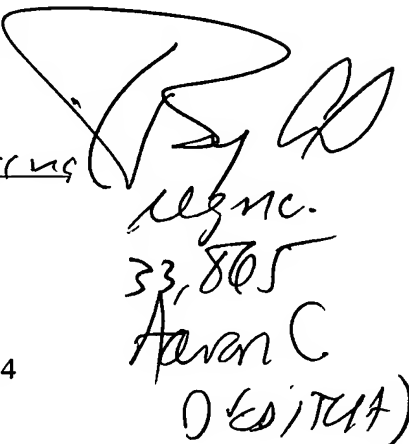
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